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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,012	04/01/2005	Frank Watjen	2815-0304PUS1	7865
2292 7590 09/12/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
CHANG, CELIA C				
ART UNIT		PAPER NUMBER		
1625				
NOTIFICATION DATE		DELIVERY MODE		
09/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/530,012

**Applicant(s)**

WATJEN, FRANK

**Examiner**

Celia Chang

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Amendment and response filed by applicants dated June 19, 2008 have been entered and considered carefully.

Claims 9-12 have been canceled. Claims 1-8 are pending.

2. The rejection of claims 9-12 under 35 USC 112 first paragraph is dropped in view of the cancellation of the claims.

3. The rejection of claims 1-8 under 35 USC 103(a) is moot in view of the following new grounds of rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. US 3,912,743 supplemented with CA81 in view of Kozikowski et al. US 6,180,648 and Moldt et al. US 6,376,673 supplemented with CA130:13920 and CA140:406740.

Determination of the scope and content of the prior art (MPEP §2141.01)

Christensen et al. '743 disclosed 4-substituted phenyl piperidinyl compounds which are made from the intermediates having the CH<sub>2</sub>-OR<sub>c</sub> moieties at the 3-position ring. A 4-chlorosubstituted compound is exemplified at col. 6, compound GF 09 for which the structure was delineated by CAS as supplemented in CA81.

US 3,912,743, US 6,180,648 and US 6,376,673 are all analogous art of antidepressant compound having the 4-substitutedphenyl piperidine core.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

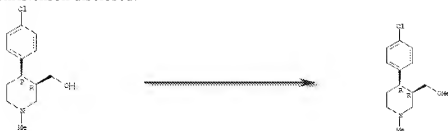
The difference between the instant claims and the Christensen '743 compound is that instead of a single halogen substituted at the 4-position of the 4-phenyl ring, the instant claims have 3,4-dihalogen substitution. Kozikowski et al. '648 taught that in analogous compounds, the 4-phenyl ring can be multiple substituted (see col. 22, lines 21-25) and which can be made from the intermediate having 3-CH<sub>2</sub>OH (see fig. 1 formula 5 or 6, fig. 2 formula 13). Moldt et al. '673 taught also in analogous compounds, the 4-phenyl ring can be multiple substituted (see col. 2 lines 51-56) and exemplified the intermediate of 3,4-dichloro substituted starting material (see col. 5 formula at lines 50-55 and structural delineation by CA130).

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art in possession of the above references is in possession of the instant claims because it is well recognized that the dichloro-substituted 4-phenyl piperidines would be expected to have similar antidepressant activity of the proven compounds disclosed by the prior art. The provision of the starting 3,4-dichlorophenyl-3-CH<sub>2</sub>OH-piperidine starting material and the proven process of transforming the 3-CH<sub>2</sub>OH-piperidinyl compound to 3-CH<sub>2</sub>-OR (see '743 col. 3 lines 15-33) would place the instant claims in artisan's possession.

That is:

Christensen disclosed:



Available:



therefore, in possession of

In absence of unexpected result, there is nothing unobvious in modifying a proven compound using the proven process to obtain another compound expected to have similar activity as taught by the prior art. Especially, CA 140 delineated the starting material for the instant claims which are *identical* to those of the prior art as delineated in CA130.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang*  
*Sept. 9, 2008*

*/Celia Chang/*  
*Primary Examiner*  
*Art Unit 1625*